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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,081	01/25/2002	Aaron Fiala	FGT 1622 PA	5142

7590

10/16/2003

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EXAMINER

CULBERT, ROBERTS P

ART UNIT

PAPER NUMBER

1763

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 10/057,081	<b>Applicant(s)</b> FIALA ET AL.	
	<b>Examiner</b> Roberts Culbert	<b>Art Unit</b> 1763	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: applicant's remarks/arguments are not persuasive. See Attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**GREGORY MILLS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

***Response to Remarks/Arguments***

Applicant's arguments filed 9/29/03 have been fully considered but they are not persuasive.

1. Applicant has argued that Garg does not teach application to an aluminum bell cup. While this is true, the rejection is based upon a combination of references including Tate, who teaches treating the surface of a bell cup to improve abrasion resistance, and Malaczynski who teaches that aluminum alloys and other metals may be coated with a hard carbon coating to improve wear resistance.
2. Applicant has argued that Malaczynski does not explicitly teach application of a hard carbon coating to aluminum. Instead Malaczynski teaches application to aluminum alloys. While it is true, that the Background section of Malaczynski only discusses aluminum alloys, the Detailed Description of Malaczynski teaches that other metals may be coated with the hard carbon coatings. See Col. 8, Lines 10-19.
3. Applicant has restated the argument that Tate does not teach application of a wear resistant coating. The definitions provided by applicant only support the position that a wear resistant coating is formed on the surface in Tate as in the claimed invention. U.S. Patent 4,597,808 to Tachikawa (previously cited by applicant) teaches a method for a nitriding treatment for an aluminum or aluminum alloy work-piece. Column 2, Lines 35-38, clearly states that the aluminum nitride layer formed is a coating layer. However the citation of this reference is not necessary in the rejection as one of ordinary skill in the art would recognize that a nitriding treatment as in Tate forms a wear resistant coating on the surface of the work-piece.
4. Applicant has argued that the addition of Kohler and Mahoney represents improper hindsight in that the examiner is picking and choosing among disclosures in non-analogous art. The argument is not persuasive because Kohler and Mahoney are directed to deposition of wear resistant carbon coatings, which are relevant to applicant's disclosure.
5. Applicant has argued that none of the references teach a chrome adhesion promoter. The argument is not persuasive because Naik teaches the claimed limitations.
6. Applicant has also argued that the hard carbon coating of Naik is not the same as in the claimed invention. These arguments are not persuasive because Naik does not simply show a carbide coating as

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stated by applicant. The coating is amorphous as in the claimed invention. Carbide is only formed at the interface with the metallic interlayer (chromium, either singularly or in combination) and then is transitioned to the fully hard compound state of the respective element (carbon) at the top surface of the hard layer. See Col. 7, lines 1-10. The interlayer and hard coating described in Naik are the same as the interlayer and coating in the claimed invention.

7. Applicant has argued that addition of Naik to Garg represents improper hindsight in that the examiner wants to substitute part of the teaching of Naik, *with out the additional layer* to Garg. This statement is not persuasive as the entire teaching of Naik is considered as stated above.

8. Further, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

10. In response to applicant's argument that certain references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

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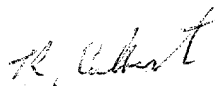
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (703) 305-7965. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (703) 308-1633. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

R. Culbert

A handwritten signature in cursive script, appearing to read 'R. Culbert', is written over the printed name.